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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09 482,731	01 14 2000	Atsushi Murakami	266036	7400

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Arlington, VA 22201-4714

EXAMINER

VO, HAI

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 05 07 2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/482.731

Applicant(s)

MURAKAMI ET AL.

Examiner

Hai Vo

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

1. Claim 5 has been cancelled in the amendment received on 03/06/02.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 50 and 51 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. "A rear air layer" limitation in the claims is nowhere supported in the original specification.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 6-11, 14, 15, 17, 19, 22-25, 28-30, 44, 48-51 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 96/28297 substantially as set forth in Paper no. 7. With regard to newly added claim 49, WO'297 discloses the round holes **11** extending through in the fiber-reinforced thermoplastic resin expanded body (figure 5, column 8, lines 5-7). With regard to newly added claims 50 and 51, WO'297 discloses the sound absorbing structure is without a rear air layer

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(examples 7-9 and comparative example 8, column 18, line 22). Since the sound absorbing component in WO'297 meets the structural limitations as required by the claims, it is the examiner's position that the compressive hardness would be inherently present in the sound absorbing component of WO'297.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4, 12, 15, 20, 21, 26, 27, and 46-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/28297 substantially as set forth in Paper No. 5.
8. Claims 31-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/28297 in view of Sensenig (US 5,888,626) substantially as set forth in Paper No. 5.
9. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/28297 in view of Burke (US 5,080,950) substantially as set forth in Paper No. 7.
- 10.** Claims 13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/28297 in view of WO 97/27370 substantially as set forth in Paper No. 7.

***Response to Arguments***

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Applicant's arguments filed 02/27/02 have been fully considered but they are not persuasive. The art rejections over WO 96/28297 are maintained because of the following reasons. At the first place, Applicant did not point out in the amendment received on 02/27/02 that the hardness of a sound absorbing element in WO'297 is not an inherent property. Secondly, Applicant simply argues that the fiber-reinforced thermoplastic elastomer in WO'297 is harder than the material of the present invention due to the presence of the reinforcing fiber in the structure which allegedly would cause the sound absorbing element of WO'297 not meet the specific range of the hardness (i.e., 25%-compressive hardness of the porous member being 0.5 N/cm<sup>2</sup> or lower) as required by the claims. There is no evidence in the record that shows the examiner that the sound absorbing element of WO'297 distinctly fails to meet the hardness range as set forth in the claims. The claims do not preclude the use of fiber reinforcement and the applied art meets the limitations of structure and chemistry, the USPTO is unequipped to perform the necessary experimentation, the burden of proof is shifted to Applicant and the rejections over WO'297 are thus sustained.

The art rejections over WO 96/28297 in view of Sensenig (US 5,888,626), Burke (US 5,080,950), and WO 97/27370 are maintained because of the following reasons. Argument that the noted secondary references do not rectify the deficiencies is not found to be persuasive. The combination of WO'297 and the secondary reference does provide a strong motivation and would not materially change the functional characteristics of the WO'297 sound absorbing element (see

pages 6-7 of Paper no. 5, regarding claims 31-43; page 4 of Paper no. 7, regarding claims 13, 18 and 45).

***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on Monday to Friday, 8:30 to 5:00 (EAST).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned

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are (703) 872-9310 for regular communications and (703) 872-9311 for After  
Final communications.

Any inquiry of a general nature or relating to the status of this application or  
proceeding should be directed to the receptionist whose telephone number is  
(703) 308-0661.

HV  
May 3, 2002



TERREL MORRIS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700